

## **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of April 14, 2004.

Reconsideration of the Application is requested.

### **Current Status of the Claims**

**Claims 1, 3-5, and 9-18** stand rejected under 35 U.S.C. §102(b) as being anticipated by Hube et al. (U.S. Patent 5,337,161).

**Claims 6 and 19** stand rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161) in view of Tonomura et al. (U.S. Patent 6,571,054).

**Claim 2** stands rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161) in view of Tonkin et al. (U.S. Patent 6,616,702).

**Claims 7 and 8** stand rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161).

### **The Interview with the Examiner**

On August 24, 2004, Applicants held a telephone interview with the Primary Examiner Ba Huynh. Applicants gratefully acknowledge the opportunity to discuss the application and cited references.

At the interview, the Applicants discussed with the Examiner that:

(1) The Applicants submitted Amendment C on June 14, 2004 in which claims 1 and 9 were amended in accordance with the consensus reached by the Applicants and the Examiners Ngon and Luu during a telephone interview on June 14, 2004. The Summary of the Interview, mailed June 21, 2004, substantially accurately reflects the Applicants understanding of the outcome of the interview. The Summary of the Interview maintains that the Hube reference would be overcome if the Applicants amend claim 1 to incorporate the data entry by the operator and carry out the limitation of claim 9 in an independent form. Despite the Applicants understanding that the amendments would be entered and the Application would be reconsidered, the amendments were not entered and the application was not reconsidered responsive to Amendment C.

(2) Examiner Bahuynh suggested the allowable subject matter if the independent claims would be amended to include the limitation of the preview frame being dynamically updated as the data is being entered into the data entry frame.

It is the Applicants understanding that as a result of the interview, the Examiner will enter the amendments and allow the case.

**Claims 1-8 and 10-14 are Allowable**

**Claim 1** calls for among other limitations: “the tab data entry frame and page preview frame are simultaneously displayed on the same screen such that the page preview frame is dynamically updated in response to the entry of the tab data into the tab data entry frame.” Initially, Applicants submit that Hube does not call for the operator interactively entering the tab data and tab content. Hube discloses a printing system that extracts a tab image from a print job. The document is initially scanned in. The user can select and extract any tab image for printing on a designated tab extension. (Column 8, lines 47-48.) To do so, the tab extraction parameters and transformation parameters such as input orientation, scaling, and the like are determined. Hube does not disclose or suggest entering the contents of the tab. To the contrary, claim 1 calls for an interactive human interface where the operator can enter tab content. Further, Hube discloses that the user selects a tab type from a menu. (Column 7, lines 14-15.) The user would select fifth-cut letter or third-cut letter tab stock. (Column 7, lines 15-16.) Claim 1 calls for an operator to enter a number of unique tab positions.

In addition, Applicants submit that Hube does not disclose or suggest displaying a page preview frame on the same screen as a tab data entry frame and dynamically updating the page preview frame as the operator enters data into the data entry frame.

It is therefore respectfully submitted that **claim 1** and dependent **claims 2-8 and 10-14** distinguish patentably and unobviously over Hube.

Turning to **claim 11**, in addition to its relationship to claim 1, claim 11 calls for a user interface that is adapted to automatically accommodate a change in tab data involving a change in tab modulus. It is alleged in the Office Action that accommodating a change in tab data involving a change in tab modulus is inherent in Hube by reference to col. 10, line 65 – col. 11, line 36. Applicants respectfully traverse this ground for rejection of claim 11. Applicants reviewed Hube at col. 10, line 65 – col. 11, line 36 and did not locate express or inherent disclosure of the limitation of claim 11. To accommodate a change in tab modulus, the document of

Hube needs to be rescanned. This is not an automatic accommodation of the change as claimed in claim 11. Nowhere does Hube disclose or suggest, expressly or inherently, a technique for automatic accommodation of a change in tab data involving a change in tab modulus. It is therefore respectfully requested that this ground for rejection of **claim 11** be withdrawn.

**Claim 9 is Allowable**

**Claim 9** was written in an independent form by incorporating the limitations of independent claim 1. Claim 9 calls for among other limitations: the tab content that includes preselected merged fields. It is alleged in the Office Action that Hube teaches the tab content including merged fields (a scale factor and a rotation factor), column 10, lines 32-49. The Applicants respectfully traverse Examiner's interpretation of scale factor and rotation factor as merged fields. According to the concepts of the present application, merged fields 150 include a listing of merged items 152 available for insertion within the tab text data entry field 120 (Fig. 1). Nowhere does Hube disclose or suggest using such merged fields. It is therefore respectfully submitted that **claim 9** distinguishes patentably and unobviously over Hube.

**Claims 17-19 are Allowable**

**Claim 17** was amended to follow claim 1. Claim 17 calls for among other limitations: displaying page preview frame with the tab data entry frame simultaneously on the same screen; and dynamically updating the page preview frame in response to the entry of the tab data into the tab data entry frame. Hube discloses that the user selects a tab type from a menu. The user would select fifth cut letter or third cut letter tab stock. (Column 7, lines 13-16.) Nowhere does Hube disclose or suggest that the user enters a unique number of tab positions and other tab data information using an interactive data entry frame and that the information entered is dynamically reflected on the page preview frame which is displayed simultaneously on the same screen. It is therefore respectfully submitted that **claim 17** and dependent **claims 18-19** distinguish patentably and unobviously over Hube.

**CONCLUSION**

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (**Claims 1-14 and 17-19**) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment D as was discussed with the Examiner Ba Huynh at the Interview. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Fay, Sharpe, Fagan, Minnich & McKee, LLP Deposit Account No. 06-0308.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Marina Zalevsky, at Telephone Number (216) 861-5582.

Respectfully submitted,

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8/24/04  
Date

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